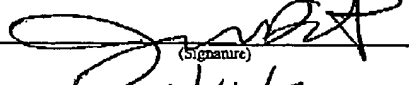


OCT 16 2006

Atty. Dkt. No. 037145-0201
(NC36985US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lehtikoinen, et al.
Title: DYNAMIC INTERNET LINKING
SYSTEM AND METHOD
Appl. No.: 10/722,807
Filing Date: 11/26/2003
Examiner: David Faber
Art Unit: 2178
Confirmation Number: 8190

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| CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below. Julienne P. Butt (Printed Name)  (Signature) 10/16/06 (Date of Deposit) |
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New Pre-Appeal Brief Conference Pilot Program, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

In the Final Office Action dated July 14, 2006, the Examiner rejected claims 1, 2, 7, 10, 13, 14, 20, 22, 27, and 31 under 35 U.S.C. §102(b) as being anticipated by U.S. 6,408,316 (Himmel et al.), hereinafter referred to as Himmel '316. The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Himmel '316 and/or in view of at least one of U.S. 6,810,395 (Bharat), U.S. 5,963,964 (Nielsen), "EXIF.org" (Hawkins), "HTML for

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the World Wide Web with XHTML and CSS: Visual Quickstart Guide, 5th Edition" (Castro), and US 2002/0156832 (Duri et al.)¹.

Applicant disagrees with all of the Examiner's rejections. In particular, Applicant submits that the Examiner's rejections are improper because none of the cited references, either alone or in combination with each other, teach or suggest a system and method for creating a dynamic bookmark, where search criteria associated with a bookmark entry is stored with a bookmarked Internet resource in a bookmark entry. In addition, none of the cited references, either alone or in combination with each other, teach or suggest updating a dynamic bookmark entry when the bookmarked Internet resource associated with the dynamic bookmark entry has changed. MPEP §2143.03 is clear that, in order for the Examiner to establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the cited prior art. The Examiner has failed to meet this burden.

The present invention as described in independent claims 1, 13, 27, and 32 addresses a situation where a previously bookmarked Internet resource (with a bookmark entry) changes. If the bookmark entry is static, like conventional bookmarks, the bookmark entry will not direct a user to the new Internet resource, making the bookmark entry unusable. To remedy this, the present invention creates a dynamic bookmark that can update the Internet resource information and/or data, e.g., URL data, associated with the dynamic bookmark. In accordance with claim 1, for example, search criteria associated with a bookmarked Internet resource is stored in a bookmark entry.

The creation of a dynamic Internet bookmark, where search criteria associated with a bookmarked Internet resource is stored in a bookmark entry, is never taught or even suggested in Himmel '316. As already discussed in the Amendment and Reply of May 22, 2006, Himmel '316 addresses the issue of adding bookmarks one at a time by creating a bookmark set as discussed in the Abstract and column 2, lines 8-51. In addition, Himmel '316 teaches

¹ It appears that the Examiner has copied, word for word, the rejection of the March 15, 2006 office action. As was pointed out by Applicant in the previous Amendment and Reply of May 22, 2006, the March 15, 2006 office action refers to one of the Himmel et al. references as being U.S. Patent #6,810,395. Applicant believes the Examiner has made typographical errors as U.S. Patent #6,810,395 is to Bharat. Applicant assumes that the Examiner meant to refer to U.S. 6,041,360 (Himmel et al.)

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using search criteria to find relevant Web pages, but it is only the pages themselves that are stored in a bookmark set. Therefore, none of the search criteria described by Himmel '316 is stored in a bookmark set, let alone a bookmark entry. Instead, a user is merely able to perform a search, receive potentially relevant Web pages and select which one(s) of those received Web pages he or she wants to include in a bookmark set. (See, e.g., column 5, line 53-column 6, line 49). By contrast, claims 1, 13, and 27 of the present application require that the actual search criteria is stored within a bookmark entry.

In the July 14, 2006 office action, the Examiner asserted that Himmel '316 "teaches search results with a URL, title, keywords, are saved as a bookmark by the user." Although Himmel '316 may teach saving search "results," search results are not analogous to search "criteria." As described at column 6, lines 23-58, Himmel '316 clearly distinguishes between a search query, which could be likened to a plurality of or set of search criteria, and search results. Search results indicate actual, relevant web pages that are retrieved from performing a search query, or from performing a search using search criteria. Search criteria can indicate, for example, search terms, keywords, and the like, input by a user to a search engine.²

Furthermore, although Himmel '316 teaches the ability to allow a user to store descriptive text or keywords in a bookmark, the descriptive text is also not analogous to the claimed search criteria. At column 6, lines 62-67 of Himmel '316, descriptive text is described as text that a user would use to understand the general content of the page without actually retrieving the page. Therefore, the descriptive text only describes the web page, not the search criteria utilized to find the web page. If search criteria were used, the descriptive text would cease to describe the web page.

Also, although Himmel '316 briefly mentions that a bookmark can be "dynamic" at column 5, line 41, no further discussion or description of what "dynamic" entails is provided. Therefore, Applicant submits that it is improper for the Examiner to rely on this recitation

² The Examiner also asserted that the phrase "actual query terms" is not recited in the claims. Applicant submits that it is not necessary to recite such a phrase to further describe search criteria because search criteria is distinguished from search results, which, for example in claim 1, can be likened to a bookmarked Internet resource or simply an Internet resource.

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when Himmel '316, as discussed above, clearly does not teach the storing of search criteria in a bookmark entry, which at least in part, is relied upon in the present invention to create a dynamic Internet bookmark. Therefore, Himmel '316 fails to teach all the limitations required by independent claims 1, 13, 27, and 32.

With regard to Bharat, the Examiner asserted that Bharat teaches creating a search results page or history file at column 4, line 50-column 7, line 4. However, as already discussed above, search results or a history file does not read on the claimed search criteria. In addition, Bharat teaches saving links or search results for association with a query. Therefore, even though Bharat teaches associating a QUERY attribute with a hypertext link retrieved during a search, that hypertext link cannot be updated, i.e., is not dynamic, as a result of the QUERY attribute. (See, e.g., column 7, line 5-column 8, line 36). Bharat is clear that the QUERY attribute merely tells browser software that the hyperlink needs to be associated with the query. This is discussed at Figure 8, where a hypertext link resulting from a search can be marked. Thereafter, whenever another search is performed utilizing the search terms identified by the QUERY attribute, any marked hyperlinks will be retrieved as well. By contrast, pending claim 1, for example, requires the creation of an actual dynamic bookmark, not a mere listing of search results that can be marked and retrieved whenever the same search is performed. The approach of Bharat is centered around the query, whereas the present invention focuses on the actual dynamic bookmark. It also should be noted that Bharat never refers to the lead or search results page or hypertext link as a "bookmark." Rather, Bharat describes the process as merely "marking" a hypertext link. Therefore, Bharat fails to cure the deficiencies of Himmel '316.

Regarding Himmel '360, the Examiner merely repeated the rejection made in the body of the July 14, 2006 office action in the Response to Arguments section. Therefore, the Examiner has not refuted in any meaningful way, the arguments presented by Applicant. As discussed in the Amendment and Reply of May 22, 2006, Applicant submits again that while Himmel '360 may teach "updating" bookmarks, it is only in a limited fashion. Specifically, the only situation in which a bookmark can be updated according to Himmel '360, is when there are redirect instructions on a previously used/abandoned Web site. In fact, column 17, lines 57-58 of Himmel '360 state that a "web browser can detect a change in either a site's

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title or URL location due to redirection.” (See also column 16, line 48-column 18, line 52). Therefore, no search criteria is ever stored or used in a search for the purpose of updating a bookmark. Furthermore, even if Himmel ‘360 were combined with Himmel ‘316, the combination would not result in the present invention, as it is clear that the mechanism utilized in Himmel ‘360 for updating bookmarks has nothing at all to do with any search criteria as required by claims 12 and 17 of the present invention. Therefore, Himmel ‘360 fails to cure the deficiencies of Himmel ‘316.

In response to the Examiner’s assertions that Duri teaches a dynamic bookmarking feature as required by claims 12 and 17 of the present application, Applicant respectfully disagrees. The feature called “dynamic” bookmarking in Duri is an entirely different feature from that of claims 12 and 17. Paragraph [0024] of Duri states that:

In these examples, a bookmark, also called a regular bookmark, in contrast to a dynamic bookmark, consists of a name (string) and a universal resource locator (URL). As used herein, a dynamic bookmark consists of a set of attributes or criteria that dynamically bind to a set of zero or more regular bookmarks...

Therefore, it would not have been obvious to one of ordinary skill in the art to combine Duri and Himmel ‘316 and ‘360, and even if such a combination was made, the resulting system would be inoperable as the operations and processes performed on and/or with the bookmarks of Duri could not be applied to the bookmarks of Himmel ‘316 and ‘360.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date October 16, 2006

By 

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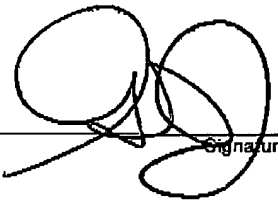
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|--|--|--|-------------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On October 16, 2006 Signature  Typed or printed name Julie P. Britt | | Application Number 10/722,807 | Filed 11/26/2003 |
| | | First Named Inventor Juha Lehtikoinen | |
| | | Art Unit 2178 | Examiner David Faber |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 37,268</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p> | | | |



Signature

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October 16, 2006
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